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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,068	06/25/2003	Henry Welling Lane	DIOP-6900	6556

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LAW OFFICE OF DEREK J. WESTBERG  
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SAN JOSE, CA 95113

EXAMINER
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MAI, HUY KIM

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,068

Applicant(s)

HENRY WELLING LANE

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. The Information Disclosure Statement (12 pages) filed on Aug. 21, 2004 is acknowledged. All references are considered. However a number of references were drawn the line through on list of 1449/PTO because they are not need to print on the front page of patent when allow the application. They are neither relevant to the claimed subject matter nor relevant to the invention discussed in the specification of the present patent application. For example: US pat. No: 3,901,589 disclose clip-on flip-up goggles. US pat. No: 4,582,401 disclose a lens occluder. US pat. No: 4,741,611 disclose an ear protector and sunglasses. US pat. No: 5,164,749 disclose clip-on sunglasses. These drawn-the-line-through references neither show in the drawings nor discuss the ventilation for eyewear. It is not understood why the applicant cites these drawn-the-line-through references. The applicant does not provide a concise explanation of relevance of these references in compliance with rule 1.98.

### *Oath/Declaration*

2. The declaration filed on Nov. 6, 2003 is acceptable.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,2,6-9,13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (4,670,914).

The limitations in claims 1,2,6-9,13-18 are shown in Harris's Figs.1,2, columns 3-4. Harris discloses an eyewear comprising a frame having a brow web 3 extending approximately horizontally from a top portion of the frame, the brow web including at least one ventilation aperture 6 having an internal side that is substantially sloped with respect to a top surface of the brow web 3 and one lens 1 mounted to the frame.

Regarding claim 6, Harris teaches, in claim 13, the internal side formed an angle of 45°.

Regarding claim 7, Harris teaches the aperture is closely adjacent to the lens channel.

Regarding claim 8,9, Harris teaches a plurality of the apertures 6 arranged substantially in a row.

Regarding claims 13-18, Harris teaches in Fig. 1, the frame including a lower web which comprising a plurality of ventilation apertures 8,9.

5. Claims 31,32,34,37-40,43,44 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al (5,969,787).

The limitations in claims 31,32,34,37-40,43,44 are shown in Hall et al's Figs. 2-10, columns 2-3.

Hall et al discloses an eyewear comprising a frame 12 including a plurality of ventilation apertures 46 having internal side that is substantially perpendicular to a wearer's line of sight toward the ventilation aperture; and one or more lenses mounted to the frame.

Regarding claims 32,34, Hall et al discloses the ventilation apertures 46 extend through the brow web 20,21.

Regarding claims 37,38, Hall et al discloses the aperture 46 is closely adjacent to the lens channel.

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Regarding claims 39,40,43,44, Hall et al discloses in Fig.7 a plurality of apertures 46 arranged substantially in a row.

6. Claims 31-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Matera (2004/0017540).

The limitations in claims 31-44 are shown in Matera's Figs. 1-9. Matera discloses an eyewear comprising a frame including a plurality of ventilation apertures 50 having internal side that is substantially perpendicular to a wearer's line of sight toward the ventilation aperture; and one or more lenses mounted to the frame wherein a plurality of apertures for each lens are arranged substantially equally-spaced in a row.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris.

Harris discloses the claimed invention in claims 3-5, as discussed above, except for the shape of the ventilation apertures. Although Harris's device does not teach the exact the shape of the apertures as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to

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modify the Harris reference by forming apertures having the same shape as the applicant's. Such a modification would have no functional differences from the Harris reference.

9. Claims 10-12, 19-30, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris.

Harris discloses an eyewear comprising a frame having a brow web 3 extending approximately horizontally from a top portion of the frame, the brow web including a plurality of ventilation apertures 6 having an internal side that is substantially sloped with respect to a top surface of the brow web 3 wherein the eyewear includes one lens instead of two lenses as claimed. Harris also suggest in column 5, lines 25-32 that "whilst the invention has been described with reference to goggles, it may also be applied to spectacles, i.e. eye protectors, in which separate lenses are provided for each eyes." It would have been obvious to a person having skilled in this art to modify the Harris's device by forming spectacles including two lenses in light of Harris's suggesting as the same as the applicant does.

Regarding method claims 48-49, it should be noted that although claims 48-49 "method claims", the method steps consist of the broad steps of "molding" and "attaching" and therefore these steps would be inherently satisfied by the apparatus of the Harris reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
May 12, 2004